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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,038	11/13/2003	Satoshi Ishikawa	0042-0491P	7110

2292 7590 12/18/2006  
BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 22040-0747

EXAMINER
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MAYES, DIONNE WALLS

ART UNIT	PAPER NUMBER
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1731

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/18/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/706,038

**Applicant(s)**

ISHIKAWA ET AL.

**Examiner**

Dionne Walls Mayes

**Art Unit**

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 5-6 are objected to because of the following informalities:

In independent claims 5-6, Applicant recites "the percentage of ash content in the surface layer is lower than a total percentage of ash content in the paper"; however, the recitation in the earlier part of the claim already states that "an ash content in a surface layer...is not higher than 35% by mass". Therefore, the former recited phrase appears to be superfluous, and thus unnecessary. It is suggested that this latter phrase be canceled from the claims.

Also, in Applicant's arguments, filed on 9/8/06, it asserts that the amount of ash in the surface layer, of the wrapper paper, is smaller than that in the central portion. But, the claims, as currently worded, do not convey this feature of the wrapper paper. If this feature is, in fact, what Applicant intends to recite and the feature is supported by the instant specification, the claims need to be amended to reflect such.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0791688.

EP 0791688 discloses all that is recited in the claims since it teaches a wrapper paper for a smoking article, wherein the paper can have a weight of  $70 \text{ g/m}^2$ , and a calcium carbonate content of 60% of the paper weight – which means  $42 \text{ g/m}^2$  (corresponding to the claimed “at least  $30 \text{ g/m}^2$ ”). The paper also can contain a chemical additive, comprising potassium citrate or sodium citrate, in the amount of from 0.3-10% by weight of the paper (corresponding to the claimed “at least 3% by mass of burn adjusting agent”). While EP 0791688 may not specifically state that an ash content in a surface layer on at least one side of the wrapper paper, or on each of a top side and a bottom side of the wrapper paper, is not higher than 35% by mass, this claim recitation is not deemed to patentably distinguish the claims from the EP reference because where the prior art product is identical or substantially identical in structure or composition, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430,433 (CCPA 1977). In other words, when the structure recited in the reference is substantially identical to that of the claims, the claimed properties or functions are presumed to be inherent. Absent any extrinsic evidence to the contrary, one having ordinary skill in the art would expect that the cigarette wrapper of EP 0791688 would also exhibit the claimed ash parameters, since, structurally, the claimed wrapper paper and that of EP 0791688 are practically identical, in that they both have the same calcium carbonate and burn adjusting agent compositions. Also, while the reference may not specifically state that the ash content in the surface layer is lower than a total ash content of the paper, it follows that this would be the case, since the ash content in the surface layer certainly

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couldn't be more than a total ash content of the paper. And, its not at all probable, or perhaps even possible, for the ash content in the surface layer to be the same as the total ash content of the paper – absent a showing or suggestion that the paper of EP 0791688 would not have any ash located in any portion of the paper other than the surface layer. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have provided the ash content to be lower in the surface layer than a total ash content of the paper.

#### ***Response to Arguments***

4. Applicant's arguments filed 9/8/06 have been fully considered but they are not persuasive.

- Applicant argues that the EP 0791688 reference fails to teach or suggest an ash content in the surface layer of the wrapper paper being lower than a total ash content of the paper; however, the Examiner disagrees for the reasons stated in the above rejection. Also, see above paragraph 2.

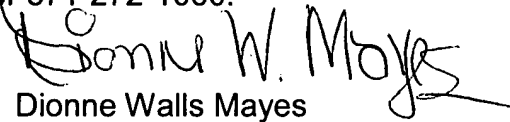
#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne Walls Mayes whose telephone number is (571) 272-1195. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Dionne Walls Mayes  
Primary Examiner  
Art Unit 1731

December 12, 2006